

REMARKS

By this amendment, Applicants amend claims 1, 9, 10, and 20, and add new claims 47-49. Claims 1-6, 8-31, and 42-40 are pending in this application of which claims 16-19, 27-31, and 42-46 have been withdrawn from consideration by the Examiner.

In the Office Action¹, the Examiner took the following actions:

objected to claim 9;

rejected claims 1-6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Haber (U.S. Re, 34,954) in view of Falls (U.S. Patent No. 6,247,149);

rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls, and in further view of Pasieka (U.S. Patent No. 6,587,945);

rejected claims 10-13, 15, 20-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Haber and Falls, and in further view of Byrd (U.S. Patent No. 6,081,899); and

rejected claims 14 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls and Byrd, and in further view of X.509.

I. Objection to Claim 9

Although Applicants respectfully traverse the objection to claim 9, Applicants have amended claim 9 for further clarity. Accordingly, Applicants request that the Examiner reconsideration withdraw the objection to the claim.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. Rejection of Claims under § 103(a)

Applicants respectfully traverse the rejection of claims 1-6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls; the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls, and in further view of Pasieka (U.S. Patent No. 6,587,945); the rejection of claims 10-13, 15, 20-23, 25, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Haber and Falls, and in further view of Byrd (U.S. Patent No. 6,081,899); and the rejection of claims 14 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Haber in view of Falls and Byrd, and in further view of X.509.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1 recites a method for authenticating an electronic message including, among other steps, "receiving, at an authentication server, the electronic message from a sender, the electronic message comprising message data and an electronic address of a recipient" and "storing, at the authentication server, a copy of the digest, the temporal stamp, the unique value, and the digital signature in a log file."

The Office Action alleges that "Haber teaches receiving the electronic message from a sender," citing column 2, line 65 to column 3, line 10. Office Action at page 3. This is not correct. Haber does not teach or suggest receiving, at an authentication server, an electronic message comprising message data and an electronic address of a recipient.

Haber discloses:

In its general application as depicted in FIG. 1 of the drawing, the present method entails an author's preparation of a digital document, which may broadly comprise any alphanumeric, audio, or pictorial presentation, and the transmission of the document, preferably in a condensed representative form, to the TSA. The TSA time-stamps the document by adding digital data signifying the current time, applying the agency's cryptographic signature scheme to the document, and transmitting the resulting document, now a certificate of the temporal existence of the original document,

back to the author where it is held for later use in required proof of such existence.

Haber, col. 2, line 65 to col. 3, line 10 (emphases added).

Although Haber discloses that an author creates a document, Haber does not teach or suggest that the document constitutes Applicants' claimed "electronic message" which includes an electronic address of a recipient. That is, Haber does not teach or suggest "receiving, **at an authentication server, the electronic message** from a sender, the electronic message comprising message data and **an electronic address** of a recipient," as recited in independent claim 1 (emphases added).

The Office Action further alleges that "Haber teaches storing [a] . . . certificate [including a copy of the digest, the temporal stamp, the unique value, and the digital signature]," citing col. 7, lines 30-35 of Haber. Office Action at page 4. However, this is also not correct.

Haber discloses:

The procedure shown in this simple one-link example results in a certificate which, being bounded in time by the data from document, D_k , provides author, A_{k-1} with reliable evidence that document, D_{k-1} , was not backdated to a time significantly prior to the existence of document, D_k . When the certificate of A_k is expanded with additional data from the subsequently processed document, D_{k+1} , it will likewise be effectively bounded to substantiate the time stamp claimed by A_k . In an alternative of the same effect, A_k could simply be advised of the identity of A_{k+1} and could confirm from that author that the one-link certificate, C_{k+1} , contained the element, H_k . The procedure could also be varied to provide certified receipts which include data from any number of authors, with each addition providing a further degree of assurance against falsification.

Col. 7, lines 30-46.

While Haber discloses providing the certificate to the author, Haber does not teach or suggest storing the certificate. Nor does Haber teach or suggest storing the certificate at the authentication server. For example, Applicant's claim 1 requires "storing, **at the authentication server**, a copy of the digest, the temporal stamp, the unique value, and the digital signature in a log file" (emphasis added). That is, the claimed "authentication server" both "receive[s] . . . the electronic message from a sender" **and** stores "a copy of the digest, the temporal stamp, the unique value, and the digital signature in a log file." Haber is silent as to an authentication server that provides both of these steps.

The other cited references, Falls, Pasieka, Byrd, and X.509, do not compensate for the deficiencies of Haber. That is, the other cited references also do not teach or suggest "receiving, at an authentication server, the electronic message from a sender, the electronic message comprising message data and an electronic address of a recipient" and "storing, at the authentication server, a copy of the digest, the temporal stamp, the unique value, and the digital signature in a log file," as recited in independent claim 1.

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. For at least the foregoing, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary

skill in view of the prior art and a *prima facie* case of obviousness has not been established.

Independent claims 10 and 20, while of a different scope from each other and claim 1, include recitations similar to those discussed above in connection with claim 1. Accordingly, for reasons similar to those discussed above, the cited references, individually or in combination, fail to teach or suggest all of the elements of claims 10 and 20. Accordingly, claims 10 and 20 are not obvious in view of the cited references for at least the reasons discussed above and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Claims 2-6, 8, 9, 11-15, and 21-26 depend from one of independent claims 1, 10, and 20. Accordingly, claims 2-6, 8, 9, 11-15, and 21-26 are not obvious in view of the cited references at least due to their dependence. Therefore, the Examiner should also withdraw the rejection of these claims under 35 U.S.C. § 103(a).

CONCLUSION


In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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